

Remarks/Arguments:

I. Status

The Office Action dated October 8, 2004 (the "Office Action") has been carefully reviewed. Claims 1, 3-4, 8 and 13 have been amended. Claims 5 and 12 have been canceled and claims 15-17 have been added. Accordingly, claims 1-4, 6-11 and 13-17 are pending in this application. Reconsideration of this application, as amended, is respectfully requested.

II. Claim Objections.

Claims 2 and 4 were objected to for failing to further limit the subject matter of a previous claim. (Office Action at page 2).

Claim 2 depends from claim 1 and adds the recitation of a payment device. Claim 4 has been amended to depend from independent claim 3, and adds the recitation of a payment device. Accordingly, the Applicants respectfully submit that the objection to claims 2 and 4 has been overcome. Therefore, the Applicants respectfully submit that the objection to claims 2 and 4 should be withdrawn.

III. The Rejection of Claims 3, 8-11, 13 and 14 under 102(e) Should be Withdrawn.

In the Office Action, claims 3, 8-11, 13 and 14 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,202,151 B1 to Musgrave et al. (hereinafter "Musgrave"). The Applicants respectfully traverse.

The Present Invention

The present invention relates to a system and method that provides access to a consumer's financial account without requiring a token or personal identifier. In one embodiment, biometric data of a consumer applying for a financial account is captured. A data record is created that includes the biometric data and financial account data of the consumer. The biometric data is then used to generate a first data storage key which is used to retrieve the data record of the consumer from a database.

In use, the consumer provides biometric data at a transaction site. The captured biometric data is transmitted to a merchant host where it is used to generate a second data storage key using the same function that was used to generate the first data storage key. A search for the consumer's financial account data is then made by comparing the second data storage key with data storage keys corresponding to data records in the database. If a corresponding first data storage key is found, the data record is retrieved, including the financial account data.

Thus, in accordance with the present invention, biometric data of a consumer is used to identify the financial account data records for that consumer.

Musgrave

Musgrave discloses a technique for combining biometric identification with digital certificates for electronic authentication. (Musgrave at Abstract). In accordance with Musgrave, a user desiring to use the technique of Musgrave is first registered. (Id. at column 6, lines 41-43). To register, the user provides proof of identity, which may be in the form of a driver's license, birth certificate, or financial account data, to the

registration authority. (Id. a column 6, lines 45-47). Once the registration authority is satisfied that the user is positively identified, biometric data of the user is obtained and the biometric data and proof of identity is entered into a biometric certificate management system (BCMS). (Id. at column 6, lines 48-52).

During a subsequent transaction, biometric data is obtained from the user and is concatenated with transaction data, a public key and other data to generate a biometric certificate as shown in FIG. 2. (Id. at column 4, lines 53-59). One of the data that is present in the biometric certificate is a unique subject ID 18 of the user. (Id. at column 5, lines 1-4). The biometric certificate is then processed and sent to the registration authority. (Id. at column 5, lines 15-32).

The registration authority processes the received data to extract the biometric certificate. (Id. at column 5, lines 37-43). The biometric certificate is then sent to the BCMS where the biometric data is extracted from the biometric certificate. (Id. at column 5, lines 45-48). The BCMS also uses the unique subject ID 18 to obtain the pre-stored biometric data from the registered user. (Id. at column 5, lines 53-56). The pre-stored biometric data is then compared to the biometric data extracted from the biometric certificate. (Id. at column 5, lines 56-59).

If the pre-stored biometric data matches the biometric data extracted from the biometric certificate, an authentication decision is generated. (Id. at column 6, lines 5-8). In response to the authentication decision, the transaction is further processed. (Id. at column 6, lines 13-15).

Accordingly, Musgrave discloses the use of biometric data to verify the identity of a user by using the user's unique identification number to retrieve stored biometric

data of the user and comparing the retrieved biometric data with biometric data captured during a transaction.

Discussion Regarding Patentability of Claim 3

1. Claim 3

Claim 3, as amended recites:

A system for supporting consumer access to a financial account by means of biometric data solely, the system comprising:

a biometric data capture device for capturing biometric data corresponding to a consumer; and
a payment device for sending said captured biometric data to a merchant payment host as the identifier for the consumer's financial account data.

Claim 3, as amended, recites a system wherein a customer's captured biometric data is used to identify the customer's financial account data.

2. Authenticating a User Is Not Identifying Financial Data

The Examiner alleged that Musgrave discloses the use of biometric data to identify financial records. (Office Action at page 3). Respectfully, the Applicant has not found any disclosure or even a suggestion in Musgrave that biometric data is used to identify financial records.

Specifically, the Examiner cited first to Musgrave at column 6, lines 16-18 as disclosing that upon authentication, a financial transaction is processed. (Office Action at page 3). However, the Examiner's proffered summary shows that the rejection of claim 3 should be withdrawn. As correctly noted by the Examiner, Musgrave only discloses that biometric data is used to *authenticate*. More specifically, the biometric data is used to verify "the authenticity of the user". (Musgrave at column 6, lines 5-8). After that

verification, Musgrave only discloses that the transaction proceeds. (See e.g. Id. at column 6, lines 12-14). However, the Applicants are not aware of any discussion in Musgrave of how the financial records of the customer that are used in such transactions are identified. Authenticating the identity of the user using biometric data is not the same as identifying financial records of the user based upon biometric data.

The Examiner has also relied upon Musgrave at column 6, lines 42-52 for the proposition that biometric data includes “instructions to lookup bank account data and other financial information in order to authenticate a transaction”. (Office Action at page 3). Respectfully, the Examiner has mischaracterized Musgrave.

At column 6, lines 42-52, Musgrave discloses “a registration process in which individuals are required to provide proof of identity”. Musgrave states that such registration is “[p]rior to the use of the disclosed biometric certification system”. (Id. at column 6, lines 42-43). Thus, in order to populate the biometric database individuals must first prove their identity. Some forms of identification which may be shown include birth certificates, driver’s license and various financial data. (Musgrave at column 6, lines 46-48). However, while this proof of identity is used to initially register a user, the Applicants have found no further discussion of how the proof of identity is used thereafter, if at all. In contrast, Musgrave clearly states that stored biometric data that is obtained during the initial registration is used in authentication of the user during subsequent transactions. (See e.g. Musgrave at column 3, lines 54-58, column 5, lines 53-59 and column 6, lines 53-56).

Accordingly, while various non-biometric data may be used to initially prove the identity of an individual being registered to use the system disclosed by Musgrave,

Musgrave does not disclose that biometric data is used thereafter to identify the non-biometric data. In fact, the non-biometric data is used to identify the biometric data. Specifically, Musgrave discloses that the user unique ID 18 is used to obtain the pre-stored biometric data. (Id. at column 5, lines 53-56). Using the identity of an entity to obtain biometric data from a database is not the same as using biometric data of a user to obtain the user's financial account data from a database.

Therefore, Musgrave does not disclose or suggest identifying financial account data using biometric data as recited in claim 3. Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Thus, because claim 3 recites a system wherein a customer's captured biometric data is used to identify the customer's financial account data and Musgrave does not disclose any such method, the Applicants submit that the rejection of claim 3 has been successfully traversed.

Discussion Regarding Patentability of Claim 8

The Examiner has rejected claim 8 based upon the same prior art discussed above with respect to claim 3. (Office Action at page 3). Claim 8 is directed to a method wherein a data record containing financial account data is retrieved using a key generated from biometric data. Thus, for the same reasons set forth above with respect to claim 3, Musgrave does not disclose steps or elements related to retrieving a data record containing financial account data using a key generated from biometric data as recited in claim 8. Therefore, claim 8 is allowable over the prior art.

Discussion Regarding Patentability of Claims 9-11

The Examiner has rejected claims 9-11 based upon the same prior art discussed above with respect to claim 8. (Office Action at pages 3-4). Claims 9-11 depend directly or by way of an intermediate claim from claim 8. Claims 9-11 thus include the steps discussed above with respect to claim 8. Thus, for at least the same reasons set forth above with respect to claim 8, claims 9-11 are allowable over the prior art.

Discussion Regarding Patentability of Claim 13

The Examiner has rejected claim 13 based upon the same prior art discussed above with respect to claim 3. (Office Action at page 4). Claim 13, as amended is directed to a method wherein a financial record is retrieved using captured biometric data. Accordingly, for at least the same reasons set forth above with respect to claim 8, Musgrave does not disclose steps or elements related to retrieving a financial record using captured biometric data as recited in claim 13. Therefore, claim 13 is allowable over the prior art.

Discussion Regarding Patentability of Claim 14

The Examiner has rejected claim 14 based upon the same prior art discussed above with respect to claim 13. (Office Action at page 5). Claim 14 depends directly from claim 13. Claim 14 thus includes the steps discussed above with respect to claim 13. Accordingly, for at least the same reasons set forth above with respect to claim 13, claim 14 is allowable over the prior art.

IV. The Rejection of Claims 1, 2, 4, 6, 7 and 12 under 103(a) Should be Withdrawn.

In the Office Action, claims 1, 2, 4, 6, 7 and 12 were rejected under 35 U.S.C. 103(a) as being obvious over Musgrave in further view of U.S. Patent No. 6,618,806 B1 to Brown et al. (hereinafter "Brown"). Claim 12 has been canceled for reasons unrelated to the above rejection. With respect to the remaining claims, the Applicants respectfully traverse.

Discussion Regarding Patentability of Claim 1

1. Claim 1

Claim 1 recites:

A system for providing consumer access to a financial account to implement a transaction comprising:
a biometric data capture device for reading consumer biometric data; and
a database server for generating a data storage key from the consumer biometric data received from the biometric data capture device and for retrieving a financial account data record corresponding to the generated data storage key.

Claim 1 thus recites a system with a database server operable to retrieve a financial account data record using a key generated from biometric data.

2. There is No Motivation to Combine the References

The Examiner appears to have acknowledged that Musgrave does not disclose a database server operable to retrieve a financial account data record using a key generated from biometric data. (Office Action at page 6). The Examiner has alleged that Brown discloses such a database server and that the motivation to modify Musgrave with Brown lies in the desire for "better efficiency and accuracy" in looking up biometric data. (Id. at

page 6). Respectfully, the Examiner has failed to provide sufficient authority for the foregoing allegations.

Specifically, the Federal Circuit has stated that “[the] factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002)(internal citations omitted). Significantly, the Federal Circuit in *In re Lee* determined that an examiner’s conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” did not adequately address the issue of motivation to combine. (*Id.* at 1343).

Similarly, in the rejection of claim 1, the Examiner has made conclusory statements but has not identified any art that discusses how a “biometric identifier record (BIR)” as taught by Brown (as alleged in the Office Action at page 6) provides better efficiency or accuracy in a system as disclosed by Musgrave.

Therefore, the Examiner has not set forth a sufficient basis or identified a proper source for the proposed motivation to combine the teachings of Musgrave with the teachings of Brown. Therefore, under MPEP § 2143.01, the Examiner has failed to present a *prima facie* case of obviousness and the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn

3. Brown Has Been Mischaracterized

As stated above, the Examiner rejected claim 1 based upon the proposition that Brown disclosed a database server operable to retrieve a financial account data record using a key generated from biometric data. (Office Action at page 6). Specifically, the Examiner has alleged that a biometric identifier record (BIR) is “stored in order to be utilized as an identifier of the records ... kept in a database” citing to Brown at column 4, lines 42-47. (Office Action at page 6). Respectfully, Brown has been mischaracterized.

Brown discloses that a BIR “contains biometric information for a user”. (Brown at column 4, lines 3-5). The BIR is further “associated in the database 221 with the corresponding user’s userID and password.” (Id. at column 4, lines 5-6). However, the applicant has not found any discussion in Brown regarding an association between the BIR and financial account data records. In fact, such a disclosure would not be expected since Brown discloses using the BIR as an alternative to using a password to authenticate a user after the user enters a userID in an attempt to logon to a computer network. (See e.g. FIG. 3 and discussion at column 4, line 60 through column 5, line 29). Thus, the “BIR” of Brown appears to be a file that contains the actual biometric data, not a file that correlates biometric data with other files.

Using a file that contains biometric data as a type of a password to gain entry to a computer network is not using biometric data to generate a key which is used to retrieve a financial account data record. Therefore, even if Musgrave is modified to include the use of biometric identifier records as taught by Brown, the modification does not arrive at invention of claim 1. Therefore, under MPEP § 2143.03, the Examiner has failed to

present a *prima facie* case of obviousness and the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn.

4. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 1 as being obvious over Musgrave in view of Brown has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn.

Discussion Regarding Patentability of Claims 2 and 4

The Examiner has rejected claims 2 and 4 based upon the same combination of prior art and the same arguments discussed above with respect to claim 1. Claims 2 and 4, as amended, depend from claims 1 and 3, respectively. Therefore, for at least the same reasons set forth above with respect to claims 1 and 3, claims 2 and 4, respectively, are allowable over the prior art.

Discussion Regarding Patentability of Claim 6

The Examiner has rejected claim 6 based upon the same prior art combination discussed above with respect to claim 1. (Office Action at page 7).¹ Claim 6 recites a system with a database server operable to retrieve data records using a key generated from biometric data. This is similar to the recitation of claim 1 discussed above. Thus,

¹ There is a minor difference in that the motivation for the proposed combination alleges only "efficiency" with respect to claim 6 in contrast with the "efficiency and accuracy" alleged with respect to claim 1.

for at least the same reasons set forth above with respect to claim 1, claim 6 is allowable over the prior art.

Discussion Regarding Patentability of Claim 7

The Examiner has rejected claim 7 based upon the same combination of prior art and the same arguments discussed above with respect to claim 6. (Office Action at page 7). Claim 7 depends from claim 6 and includes all of the limitations of claim 6.

Therefore, for at least the same reasons set forth above with respect to claim 6, claim 7 is allowable over the prior art.

V. Claims 15-17.

Claims 15-17 have been added. These claims recite novel and non-obvious limitations. Accordingly, claims 15-17 are believed to be allowable over the prior art.

VI. Conclusion

Applicants respectfully request entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully Submitted,
Maginot, Moore & Beck

A handwritten signature in black ink, appearing to read "James D. Wood", written in a cursive style.

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